



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/937,722 | 03/28/2002 | Ralf-Peter Franke | CERA-233 | 7010 |
| 24972 | 7590 | 03/13/2006 | EXAMINER | |
| FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198 | | | DAVIS, DANIEL J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3733 | |
| DATE MAILED: 03/13/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,722

Applicant(s)

FRANKE ET AL.

Examiner

D. Jacob Davis

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-91 is/are pending in the application.
- 4a) Of the above claim(s) 60-63, 65, 68, 69, 72-74, 80-82 and 84-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59, 63, 64, 66, 67, 70, 71, 76-79 and 83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 59, 64, 66, 70, 71, 76, 77 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,531,555 to Tatematsu et al. Tatematsu discloses in figure 1 scissors fully capable of being used in surgery. The scissors having blades consisting of silicon nitride ceramic (column 3, lines 53-57 and column 4, lines 4-11). Examiner interprets the “instrument” and the “tool” as not referring to the entire mechanism, but the effecting end or the effecting portion of the device. For example, applicant’s “drill” is actually a drill bit and not an entire drill.

Claims 59, 63, 64, 66, 67, 71, 76-79 and 83 are rejected under 102(a) as being anticipated by U.S. Patent No. 5,879,406 to Lilley. Lilley discloses an “instrument/tool” in column 7, lines 54-60 wherein the device may be used as a trial, which is a tool and not an implant. A trial is considered a template since it is used to determine an appropriate size or location for the prosthetic.

Response to Arguments

Applicants' arguments, filed December 16, 2005, with respect to the rejection under 35 U.S.C. 112, first paragraph have been fully considered and are persuasive and is withdrawn. Applicant further traversed the rejections anticipated by Lilley since the rejections were inappropriately made under 35 U.S.C. 102(e). The rejection is now appropriately made under 35 U.S.C. 102(a) since the reference was published before applicant's invention.

Applicants' arguments regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. The fact that the Tatematsu device does not have thumb/finger holes does not preclude its use in surgery. The scissor blades inherently comprise a "biocompatible bioinert" material since applicants also disclose a silicon nitride ceramic, which is "biocompatible and bioinert."

Regarding the rejection under Lilley, trial devices are considered tools or instruments and not implants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER